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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/161,257	09/25/98	BUAZZA	5040-03703

IM62/1121

ERIC B MEYERTONS
CONLEY ROSE & TAYON PC
P O BOX 398
AUSTIN TX 78767-0398

EXAMINER	
VARGOT, M	
ART UNIT	**PAPER NUMBER**
1732	13

DATE MAILED: 11/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/161,257	BUAZZA
Examiner	**Group Art Unit**
M. UHLENHOPT	1732

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 9/12/00.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 194-214 & 217 is/are pending in the application.

Of the above claim(s)_____ is/are withdrawn from consideration.

☐ Claim(s)_____ is/are allowed.

☒ Claim(s) 194-214 & 217 is/are rejected.

☐ Claim(s)_____ is/are objected to.

☐ Claim(s)_____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on_____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on_____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number)_____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received:_____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3, 6, 9 & 11

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other_____

Office Action Summary

1. Claims 194-214 and 217 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In independent claims 194 and 217, the recitation "photoinitiator configured...**during use**" is indefinite in that it is unclear if applicant means during the curing or during the wearing of the lens. This language is vague and should be clarified. See also claim 202, last line.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 194-201 and 203-214 are rejected under 35 U.S.C. 102(b) as being anticipated by Buazza et al -728. The applied reference discloses the instant claimed subject matter, including the aspects of resin monomers and initiators, UV light application at gel point, mold cooling, hard coating and filtering the UV light.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 202 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buazza et al -728.

The applied reference discloses the basic claimed invention lacking essentially a clear teaching of the adhesion promoter. In that adhesion is recognized to be a problem, it would have been obvious to employ an adhesion promoter in the process of the applied reference to reduce premature separation of the lens.

4. Claim 217 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buazza et al -728 in view of Kindt-Larsen et al -664.

The primary reference discloses the basic claimed method lacking essentially a teaching of using a coinitiator. Kindt-Larsen et al -664 discloses that such is well known in the lens making art and it is further submitted that such is well known generally in the polymer art. It would have been obvious to one of ordinary skill in the art to employ a coinitiator as taught by Kindt-Larsen et al -664 in the method of Buazza et al -728 to facilitate the curing.

5. Claim 217 is directed to an invention not patentably distinct from the claims of commonly assigned U.S Patent 5,989,462. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claim sets forth an initiator and a coinitiator being used in a method to make a lens and so does U.S. Patent 5,989,462. The assignee is required to either name the inventor of the conflicting subject matter under 102(f) or (g) or show that the inventions were commonly owned a the time of the instant invention.

6. Claim 217 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 5,989,462. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons noted in paragraph 5, supra.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Vargot whose telephone number is (703) 308-2621.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

M. Vargot

November 20, 2000

M. Vargot

MATHIEU D. VARGOT
PRIMARY EXAMINER
GROUP 1300

11/20/00